

**IN THE UNITED STATES DISTRICT
COURT FOR THE EASTERN DISTRICT
OF TEXAS SHERMAN DIVISION**

AMERICAN PATENTS LLC,

Plaintiff,

v.

TCL CORP., TCL COMMUNICATION
LTD., TCL COMMUNICATION
TECHNOLOGY HOLDINGS LTD., TCL
ELECTRONICS HOLDINGS LTD., TCL
KING ELECTRICAL APPLIANCES
(HUIZHOU) CO. LTD., and
BLACKBERRY LIMITED,

Defendants.

CIVIL ACTION NO. 4:18-cv-767

ORIGINAL COMPLAINT FOR
PATENT INFRINGEMENT

JURY TRIAL DEMANDED

**ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS TO PLAINTIFF'S
ORIGINAL COMPLAINT FOR PATENT INFRINGEMENT**

Defendant BlackBerry Limited (“BlackBerry” or “Defendant”), by and through its undersigned counsel, hereby submit its Answer, Affirmative Defenses and Counterclaims to Plaintiff American Patents LLC (“American Patents” or “Plaintiff”) Original Complaint for Patent Infringement (“Complaint”). BlackBerry denies all allegations in the Complaint not specifically admitted below, and asserts the affirmative defenses and counterclaims as specified below. In responding to the Complaint, BlackBerry uses the headings employed by Plaintiff’s strictly as a convenience to the Court, and does not admit any allegation made in, or inference suggested by, such headings. BlackBerry answers the numbered paragraphs of the Complaint as follows:

RESPONSE TO ALLEGATIONS CONCERNING THE PARTIES

1. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 1, and therefore denies them.

2. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 2, and therefore denies them.

3. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 3, and therefore denies them.

4. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 4, and therefore denies them.

5. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 5, and therefore denies them.

6. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 6, and therefore denies them.

7. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 7, and therefore denies them.

8. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 8, and therefore denies them.

9. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 9, and therefore denies them.

10. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 10, and therefore denies them.

11. Admitted.

12. BlackBerry denies the allegations in Paragraph 12.

13. The allegations in Paragraph 13 contain legal conclusions to which no answer is required. BlackBerry does not contest that, for the purposes of this action, and without waiving any defense of improper joinder in connection with any other cause of action or claim, joinder is

technically proper in this District pursuant to 35 U.S.C. § 299 with respect to certain BlackBerry branded DTEK 50 and DTEK 60 products only. To the extent an answer is required, and to the extent not expressly admitted herein, BlackBerry denies the remaining allegations of Paragraph 13.

RESPONSE TO ALLEGATIONS CONCERNING THE JURISDICTION AND VENUE

14. BlackBerry admits that the Complaint purports to set forth an action for patent infringement. BlackBerry denies that it has infringed any of Plaintiff's patents, or that Plaintiff is entitled to relief under 35 U.S.C. §§ 284 and/or 285. BlackBerry admits that this Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a) because this is a civil action for alleged patent infringement arising under the United States patent statutes. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations of Paragraph 14.

15. BlackBerry does not contest that, for purposes of this action only, this Court has personal jurisdiction over BlackBerry Limited. The remaining allegations in Paragraph 15 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies each and every allegation of Paragraph 15.

16. BlackBerry does not contest that, for the purposes of this action, and without waiving any defense of improper venue in connection with any other cause of action or claim, venue is technically proper in this District pursuant to 28 U.S.C. §1391(c)(3) with respect to BlackBerry Limited. However, BlackBerry denies that this District is the most appropriate or convenient forum, and BlackBerry reserves its right to seek transfer pursuant to 28 U.S.C. § 1404. BlackBerry denies the remaining allegations in Paragraph 16.

17. BlackBerry does not contest that, for the purposes of this action, and without waiving any defense of improper venue in connection with any other cause of action or claim,

venue is technically proper in this District pursuant to 28 U.S.C. §1391(c)(3) with respect to BlackBerry Limited. However, BlackBerry denies that this District is the most appropriate or convenient forum, and BlackBerry reserves its right to seek transfer pursuant to 28 U.S.C. § 1404. BlackBerry further states that 28 U.S.C. §1391(c)(3) speaks for itself. BlackBerry denies the remaining allegations in Paragraph 17.

RESPONSE TO ALLEGATIONS CONCERNING THE BACKGROUND

18. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 18, and therefore denies them.

19. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 19, and therefore denies them.

20. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 20, and therefore denies them

21. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 21, and therefore denies them

RESPONSE TO ALLEGATIONS CONCERNING COUNT I
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 7,088,782

22. BlackBerry states that U.S. Patent No. 7,088,782 (“the ’782 Patent”) speaks for itself. The remaining allegations in Paragraph 22 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 22.

23. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 23, and therefore denies the allegations in Paragraph 23.

24. BlackBerry denies the allegations in Paragraph 24.

25. BlackBerry denies the allegations in Paragraph 25.

26. BlackBerry denies the allegations in Paragraph 26.

27. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 27, and therefore denies the allegations in Paragraph 27.

28. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 28, and therefore denies the allegations in Paragraph 28.

29. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 29, and therefore denies the allegations in Paragraph 29.

30. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 30, and therefore denies the allegations in Paragraph 30.

31. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 31, and therefore denies the allegations in Paragraph 31.

32. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 32, and therefore denies the allegations in Paragraph 32.

33. BlackBerry admits that it became aware of the '782 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 33.

34. BlackBerry denies the allegations in Paragraph 34.

35. BlackBerry denies the allegations in Paragraph 35.

RESPONSE TO ALLEGATIONS CONCERNING COUNT II
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 7,310,304

36. BlackBerry states that U.S. Patent No. 7,310,304 ("the '304 Patent") speaks for itself. The remaining allegations in Paragraph 36 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 36.

37. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 37, and therefore denies the allegations in Paragraph 37.

38. BlackBerry denies the allegations in Paragraph 38.

39. BlackBerry denies the allegations in Paragraph 39.

40. BlackBerry denies the allegations in Paragraph 40.

41. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 41, and therefore denies the allegations in Paragraph 41.

42. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 42, and therefore denies the allegations in Paragraph 42.

43. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 43, and therefore denies the allegations in Paragraph 43.

44. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 44, and therefore denies the allegations in Paragraph 44.

45. BlackBerry admits that U.S. Patent Application Publication No. 2002/0181390 was listed on an Information Disclosure Statement submitted to the U.S. Patent & Trademark Office on January 3, 2014, in connection with U.S. Patent Application No. 12/806,185, which later issued as U.S. Patent No. 8,811,339 assigned to BlackBerry Limited. BlackBerry further admits that the named inventors of U.S. Patent No. 8,811,339 are Mo-Han Fong, Hang Zhang, Sophie Vrzic and Robert Novak. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 45.

46. BlackBerry admits that it became aware of the '304 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 46.

47. BlackBerry denies the allegations in Paragraph 47.

48. BlackBerry denies the allegations in Paragraph 48.

RESPONSE TO ALLEGATIONS CONCERNING COUNT III
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 7,706,458

49. BlackBerry states that U.S. Patent No. 7,706,458 (“the ’458 Patent”) speaks for itself. The remaining allegations in Paragraph 49 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 49.

50. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 50, and therefore denies the allegations in Paragraph 50.

51. BlackBerry denies the allegations in Paragraph 51.

52. BlackBerry denies the allegations in Paragraph 52.

53. BlackBerry denies the allegations in Paragraph 53.

54. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 54, and therefore denies the allegations in Paragraph 54.

55. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 55, and therefore denies the allegations in Paragraph 55.

56. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 56, and therefore denies the allegations in Paragraph 56.

57. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 57, and therefore denies the allegations in Paragraph 57.

58. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 58, and therefore denies the allegations in Paragraph 58.

59. BlackBerry admits that it became aware of the '458 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 59.

60. BlackBerry denies the allegations in Paragraph 60.

61. BlackBerry denies the allegations in Paragraph 61.

RESPONSE TO ALLEGATIONS CONCERNING COUNT IV
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 7,373,655

62. BlackBerry states that U.S. Patent No. 7,373,655 ("the '655 Patent") speaks for itself. The remaining allegations in Paragraph 62 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 62.

63. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 63, and therefore denies the allegations in Paragraph 63.

64. BlackBerry denies the allegations in Paragraph 64.

65. BlackBerry denies the allegations in Paragraph 65.

66. BlackBerry denies the allegations in Paragraph 66.

67. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 67, and therefore denies the allegations in Paragraph 67.

68. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 68, and therefore denies the allegations in Paragraph 68.

69. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 69, and therefore denies the allegations in Paragraph 69.

70. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 70, and therefore denies the allegations in Paragraph 70.

71. BlackBerry admits that it became aware of the '655 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 71.

72. BlackBerry denies the allegations in Paragraph 72.

73. BlackBerry denies the allegations in Paragraph 73.

RESPONSE TO ALLEGATIONS CONCERNING COUNT V
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 7,934,090

74. BlackBerry states that U.S. Patent No. 7,934,090 ("the '090 Patent") speaks for itself. The remaining allegations in Paragraph 74 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 74.

75. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 75, and therefore denies the allegations in Paragraph 75.

76. BlackBerry denies the allegations in Paragraph 76.

77. BlackBerry denies the allegations in Paragraph 77.

78. BlackBerry denies the allegations in Paragraph 78.

79. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 79, and therefore denies the allegations in Paragraph 79.

80. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 80, and therefore denies the allegations in Paragraph 80.

81. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 81, and therefore denies the allegations in Paragraph 81.

82. BlackBerry admits that it became aware of the '090 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 82.

83. BlackBerry denies the allegations in Paragraph 83.

84. BlackBerry denies the allegations in Paragraph 84.

RESPONSE TO ALLEGATIONS CONCERNING COUNT VI
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 6,004,049

85. BlackBerry states that U.S. Patent No. 6,004,049 ("the '049 Patent") speaks for itself. The remaining allegations in Paragraph 85 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 85.

86. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 86, and therefore denies the allegations in Paragraph 86.

87. BlackBerry denies the allegations in Paragraph 87.

88. BlackBerry denies the allegations in Paragraph 88.

89. BlackBerry denies the allegations in Paragraph 89.

90. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 90, and therefore denies the allegations in Paragraph 90.

91. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 91, and therefore denies the allegations in Paragraph 91.

92. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 92, and therefore denies the allegations in Paragraph 92.

93. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 93, and therefore denies the allegations in Paragraph 93.

94. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 94, and therefore denies the allegations in Paragraph 94.

95. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 95, and therefore denies the allegations in Paragraph 95.

96. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 96, and therefore denies the allegations in Paragraph 96.

97. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 97, and therefore denies the allegations in Paragraph 97.

98. BlackBerry admits that it became aware of the '049 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 98.

99. BlackBerry denies the allegations in Paragraph 99.

100. BlackBerry denies the allegations in Paragraph 100.

RESPONSE TO ALLEGATIONS CONCERNING COUNT VII
ALLEGATIONS OF DIRECT INFRINGEMENT OF U.S. PATENT NO. 6,301,626

101. BlackBerry states that U.S. Patent No. 6,301,626 (“the '626 Patent”) speaks for itself. The remaining allegations in Paragraph 101 contain legal conclusions to which no answer is required. To the extent an answer is required, BlackBerry denies any and all remaining allegations in Paragraph 101.

102. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 102, and therefore denies the allegations in Paragraph 102.

103. BlackBerry denies the allegations in Paragraph 103.

104. BlackBerry denies the allegations in Paragraph 104.

105. BlackBerry denies the allegations in Paragraph 105.

106. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 106, and therefore denies the allegations in Paragraph 106.

107. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 107, and therefore denies the allegations in Paragraph 107.

108. BlackBerry denies the allegations in Paragraph 108.

109. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 109, and therefore denies the allegations in Paragraph 109.

110. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 110, and therefore denies the allegations in Paragraph 110.

111. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 111, and therefore denies the allegations in Paragraph 111.

112. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 112, and therefore denies the allegations in Paragraph 112.

113. BlackBerry lacks knowledge and information sufficient to form a belief as to the truth of the allegations of Paragraph 113, and therefore denies the allegations in Paragraph 113.

114. BlackBerry admits that it became aware of the '626 Patent as of the date of the service of this Complaint. To the extent not expressly admitted herein, BlackBerry denies the remaining allegations in Paragraph 114.

115. BlackBerry denies the allegations in Paragraph 115.

116. BlackBerry denies the allegations in Paragraph 116.

**RESPONSE TO ADDITIONAL ALLEGATIONS REGARDING INDIRECT
INFRINGEMENT**

117. BlackBerry denies the allegations in Paragraph 117.

118. BlackBerry denies the allegations in Paragraph 118.

119. BlackBerry denies the allegations in Paragraph 119.

120. BlackBerry denies the allegations in Paragraph 120.

121. BlackBerry denies the allegations in Paragraph 121.

122. BlackBerry denies the allegations in Paragraph 122.

123. BlackBerry states that 35 U.S.C. § 284 speaks for itself. To the extent not expressly admitted, BlackBerry denies the allegations in Paragraph 123.

RESPONSE TO ALLEGATIONS IN THE JURY DEMAND

This sentence contains a demand for a jury trial to which no response is required.

PRAYER FOR RELIEF

BlackBerry denies that Plaintiff is entitled to any of the relief sought in its Prayer for Relief.

AFFIRMATIVE DEFENSES

Subject to its responses above, and upon information and belief, BlackBerry alleges and asserts the following defenses in response to the allegations of the Complaint. Regardless of how such defenses are listed herein, BlackBerry undertakes the burden of proof only as to those defenses that are deemed affirmative defenses as a matter of law. In addition to the affirmative defenses described below, BlackBerry reserves the right to amend or raise additional affirmative defenses pursuant to any docket control order or as additional information becomes available through further investigation and discovery.

FIRST AFFIRMATIVE DEFENSE **(Non-infringement)**

1. BlackBerry does not infringe and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid and enforceable claim of the '782, '304, '458, '655, '090, '049 or '626 Patents (collectively, the "Patents-in-Suit").

SECOND AFFIRMATIVE DEFENSE
(Invalidity and Patent Ineligibility)

2. One or more claims of the Patents-in-Suit are invalid, unenforceable, patent ineligible and/or void for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

THIRD AFFIRMATIVE DEFENSE
(Equitable Defenses)

3. Plaintiff's claims are barred, in whole or in part, by the doctrines of waiver, implied waiver, acquiescence, equitable estoppel, unclean hands, and/or other equitable defenses.

FOURTH AFFIRMATIVE DEFENSE
(Limitation on Damages)

4. Pursuant to the requirements of 35 U.S.C. §§ 286-288, Plaintiff's ability to recover damages and/or costs is limited. Without limitation, Plaintiff's pre-lawsuit claims for damages are barred, in whole or in part, for failure to comply with the marking and notice requirements of 35 U.S.C. § 287. BlackBerry alleges on information and belief that any claim for damages for patent infringement by Plaintiff is limited by 35 U.S.C. § 287 to only those damages occurring after proper and sufficient notice of alleged infringement to BlackBerry.

5. To the extent that Plaintiff is asserting that any Patent-in-Suit is a standard-essential patent, in the event that BlackBerry is found to infringe any valid and enforceable claims of the Patents-in-Suit, damages for any of the Patents-in-Suit subject to obligations to license them on fair, reasonable, and non-discriminatory terms is at least limited to such fair, reasonable, and non-discriminatory terms, or, in the event that any predecessor-in-interest of the Patents-in-Suit committed to license such patents on royalty-free terms, there are no damages for such infringement.

FIFTH AFFIRMATIVE DEFENSE
(Prosecution History Estoppel)

6. Plaintiff's claims of patent infringement are barred in whole or in part by the doctrine of prosecution history estoppel.

SIXTH AFFIRMATIVE DEFENSE
(28 U.S.C. § 1498)

7. Plaintiff's claims of patent infringement are barred in whole or in part by 28 U.S.C. § 1498 to the extent Plaintiff claims infringement of devices sold to and/or designed for the United States.

SEVENTH AFFIRMATIVE DEFENSE
(Exceptional Case)

8. Plaintiff cannot prove that this is an exceptional case justifying award of attorney fees against BlackBerry pursuant to 35 U.S.C. § 285.

9. This is an exceptional case justifying an award of attorney fees against Plaintiff pursuant to 35 U.S.C. § 285.

EIGHTH AFFIRMATIVE DEFENSE
(Express License, Implied License, Patent Exhaustion, and/or the Single Recovery Rule)

10. To the extent any of the Patents-in-Suit have been licensed to a supplier or customer of BlackBerry, Plaintiff's claims are barred, in whole or in part, by express license agreements and/or under the doctrines of implied license, patent exhaustion, and/or the single recovery rule.

NINTH AFFIRMATIVE DEFENSE
(Failure to State a Claim)

11. The Complaint has failed to state a claim upon which relief can be granted.

TENTH AFFIRMATIVE DEFENSE
(No Injunctive Relief)

12. Plaintiff is not entitled to any injunctive relief because any alleged injury to Plaintiff is neither immediate nor irreparable, and Plaintiff has adequate remedies at law.

ELEVENTH AFFIRMATIVE DEFENSE
(Breach of Contract)

13. To the extent that Plaintiff is asserting that any of the Patents-in-Suit is a standard-essential patent, Plaintiff's claims for relief are barred, in whole or in part, by the defense of breach of contract to the extent that Plaintiff or its predecessors-in-interest to the Patents-in-Suit breached their contractual obligations to disclose the Patents-in-Suit to standard-setting organizations and/or to license them under royalty free terms and/or under fair, reasonable and nondiscriminatory terms.

THIRTEENTH DEFENSE
(Reservation of Remaining Defenses)

14. BlackBerry reserves all defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the Patent Laws of the United States and any other defenses, at law or in equity, which may now exist or in the future be available based on discovery.

COUNTERCLAIMS

BlackBerry Limited ("BlackBerry") assert the following counterclaims against American Patents LLC ("American Patents").

THE PARTIES AND NATURE OF THE ACTION

1. BlackBerry is a Canadian company having a principal place of business at 2200 University Ave. E, Waterloo, ON, Canada N2K 0A7.

2. In its Complaint, American Patents states that it is a limited liability company formed under the laws of the State of Texas, with its principal place of business at 2325 Oak Alley,

Tyler, Texas, 75703.

3. This is a Declaratory Judgment action for a declaration of non-infringement and invalidity of United States Patent Nos. 7,088,782 (“the ’782 Patent”), 7,310,304 (“the ’304 Patent”), 7,706,458 (“the ’458 Patent”), 7,373,655 (“the ’655 Patent”), 7,934,090 (“the ’090 Patent”), 6,004,049 (“the ’049 Patent”) and 6,301,626 (“the ’626 Patent”) (collectively, the “Patents-in-Suit”).

JURISDICTION AND VENUE

4. This Court has jurisdiction over BlackBerry’s Declaratory Judgment claims pursuant to 28 U.S.C. §§ 2201–2202, and has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a). This Counterclaim also arises under the patent laws of the United States, Title 35, United States Code.

5. American Patents has submitted to personal jurisdiction of this Court through the filing of its Complaint against BlackBerry.

6. Venue is technically proper in this District pursuant to 28 U.S.C. §§ 1391 and 1400 because American Patents has submitted to the venue of this Court by filing its Complaint here. However, this District is not necessarily the most convenient forum for this action to be heard, and BlackBerry reserves all rights to seek a transfer under 28 U.S.C. § 1404.

COUNT I – DECLARATION OF NON-INFRINGEMENT OF THE ’782 PATENT

7. The allegations of Paragraphs 1 through 6 of this Counterclaim are restated and incorporated herein by reference.

8. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the ’782 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the ’782 Patent.

9. BlackBerry has denied American Patents' claims of infringement. BlackBerry does not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '782 Patent.

10. Absent a declaration that BlackBerry does not infringe any valid claim of the '782 Patent, American Patents will continue to wrongfully assert the '782 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

11. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '782 Patent either literally or under the doctrine of equivalents.

COUNT II – DECLARATION OF INVALIDITY OF THE '782 PATENT

12. The allegations of Paragraphs 1 through 11 of this Counterclaim are restated and incorporated herein by reference.

13. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning whether the '782 Patent is valid. By its Complaint, American Patents has asserted that the claims of the '782 Patent are valid.

14. BlackBerry has asserted that one or more claims of the '782 Patent are invalid. One or more claims of the '782 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

15. Absent a declaration that the claims of the '782 Patent are invalid, American Patents will continue to wrongfully assert the '782 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause

BlackBerry irreparable injury and damage.

16. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '782 Patent is invalid.

COUNT III – DECLARATION OF NON-INFRINGEMENT OF THE '304 PATENT

17. The allegations of Paragraphs 1 through 16 of this Counterclaim are restated and incorporated herein by reference.

18. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the '304 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the '304 Patent.

19. BlackBerry has denied American Patents' claims of infringement. BlackBerry does not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '304 Patent.

20. Absent a declaration that BlackBerry does not infringe any valid claim of the '304 Patent, American Patents will continue to wrongfully assert the '304 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

21. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '304 Patent either literally or under the doctrine of equivalents.

COUNT IV – DECLARATION OF INVALIDITY OF THE '304 PATENT

22. The allegations of Paragraphs 1 through 21 of this Counterclaim are restated and incorporated herein by reference.

23. An actual and justiciable controversy has arisen and now exists between

BlackBerry and American Patents concerning whether the '304 Patent is valid. By its Complaint, American Patents has asserted that the claims of the '304 Patent are valid.

24. BlackBerry has asserted that one or more claims of the '304 Patent are invalid. One or more claims of the '304 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

25. Absent a declaration that the claims of the '304 Patent are invalid, American Patents will continue to wrongfully assert the '304 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

26. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '304 Patent is invalid.

COUNT V – DECLARATION OF NON-INFRINGEMENT OF THE '458 PATENT

27. The allegations of Paragraphs 1 through 26 of this Counterclaim are restated and incorporated herein by reference.

28. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the '458 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the '458 Patent.

29. BlackBerry has denied American Patents' claims of infringement. BlackBerry does not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '458 Patent.

30. Absent a declaration that BlackBerry does not infringe any valid claim of the '458 Patent, American Patents will continue to wrongfully assert the '458 Patent against BlackBerry in

violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

31. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '458 Patent either literally or under the doctrine of equivalents.

COUNT VI – DECLARATION OF INVALIDITY OF THE '458 PATENT

32. The allegations of Paragraphs 1 through 31 of this Counterclaim are restated and incorporated herein by reference.

33. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning whether the '458 Patent is valid. By Its Complaint, American Patents has asserted that the claims of the '458 Patent are valid.

34. BlackBerry has asserted that one or more claims of the '458 Patent are invalid. One or more claims of the '458 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

35. Absent a declaration that the claims of the '458 Patent are invalid, American Patents will continue to wrongfully assert the '458 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

36. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '458 Patent is invalid.

COUNT VII – DECLARATION OF NON-INFRINGEMENT OF THE '655 PATENT

37. The allegations of Paragraphs 1 through 36 of this Counterclaim are restated and

incorporated herein by reference.

38. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the '655 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the '655 Patent.

39. BlackBerry has denied American Patents' claims of infringement. BlackBerry does not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '655 Patent.

40. Absent a declaration that BlackBerry does not infringe any valid claim of the '655 Patent, American Patents will continue to wrongfully assert the '655 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

41. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '655 Patent either literally or under the doctrine of equivalents.

COUNT VIII – DECLARATION OF INVALIDITY OF THE '655 PATENT

42. The allegations of Paragraphs 1 through 41 of this Counterclaim are restated and incorporated herein by reference.

43. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning whether the '655 Patent is valid. By its Complaint, American Patents has asserted that the claims of the '655 Patent are valid.

44. BlackBerry has asserted that one or more claims of the '655 Patent are invalid. One or more claims of the '655 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35

U.S.C. §§ 101, 102, 103, and/or 112.

45. Absent a declaration that the claims of the '655 Patent are invalid, American Patents will continue to wrongfully assert the '655 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

46. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '655 Patent is invalid.

COUNT IX – DECLARATION OF NON-INFRINGEMENT OF THE '090 PATENT

47. The allegations of Paragraphs 1 through 46 of this Counterclaim are restated and incorporated herein by reference.

48. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the '090 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the '090 Patent.

49. BlackBerry has denied American Patents' claims of infringement. BlackBerry does not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '090 Patent.

50. Absent a declaration that BlackBerry does not infringe any valid claim of the '090 Patent, American Patents will continue to wrongfully assert the '090 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

51. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '090 Patent either literally or under the doctrine of equivalents.

COUNT X – DECLARATION OF INVALIDITY OF THE '090 PATENT

52. The allegations of Paragraphs 1 through 51 of this Counterclaim are restated and incorporated herein by reference.

53. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning whether the '090 Patent is valid. By its Complaint, American Patents has asserted that the claims of the '090 Patent are valid.

54. BlackBerry has asserted that one or more claims of the '090 Patent are invalid. One or more claims of the '090 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

55. Absent a declaration that the claims of the '090 Patent are invalid, American Patents will continue to wrongfully assert the '090 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

56. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '090 Patent is invalid.

COUNT XI – DECLARATION OF NON-INFRINGEMENT OF THE '049 PATENT

57. The allegations of Paragraphs 1 through 56 of this Counterclaim are restated and incorporated herein by reference.

58. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the '049 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the '049 Patent.

59. BlackBerry has denied American Patents' claims of infringement. BlackBerry does

not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '049 Patent.

60. Absent a declaration that BlackBerry does not infringe any valid claim of the '049 Patent, American Patents will continue to wrongfully assert the '049 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

61. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '049 Patent either literally or under the doctrine of equivalents.

COUNT XII – DECLARATION OF INVALIDITY OF THE '049 PATENT

62. The allegations of Paragraphs 1 through 61 of this Counterclaim are restated and incorporated herein by reference.

63. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning whether the '049 Patent is valid. By its Complaint, American Patents has asserted that the claims of the '049 Patent are valid.

64. BlackBerry has asserted that one or more claims of the '049 Patent are invalid. One or more claims of the '049 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

65. Absent a declaration that the claims of the '049 Patent are invalid, American Patents will continue to wrongfully assert the '049 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

66. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '049 Patent is invalid.

COUNT XIII – DECLARATION OF NON-INFRINGEMENT OF THE '626 PATENT

67. The allegations of Paragraphs 1 through 66 of this Counterclaim are restated and incorporated herein by reference.

68. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning the '626 Patent. By its Complaint, American Patents has asserted that BlackBerry has infringed one or more claims of the '626 Patent.

69. BlackBerry has denied American Patents' claims of infringement. BlackBerry does not and has not infringed, directly, indirectly, literally or by the doctrine of equivalents, any valid claim of the '626 Patent.

70. Absent a declaration that BlackBerry does not infringe any valid claim of the '626 Patent, American Patents will continue to wrongfully assert the '626 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

71. Because the above actions and activities have created an actual and justiciable controversy, BlackBerry seeks a declaration that it does not and has not infringed, directly or indirectly, any valid claim of the '626 Patent either literally or under the doctrine of equivalents.

COUNT XIV – DECLARATION OF INVALIDITY OF THE '626 PATENT

72. The allegations of Paragraphs 1 through 71 of this Counterclaim are restated and incorporated herein by reference.

73. An actual and justiciable controversy has arisen and now exists between BlackBerry and American Patents concerning whether the '626 Patent is valid. By its Complaint,

American Patents has asserted that the claims of the '626 Patent are valid.

74. BlackBerry has asserted that one or more claims of the '626 Patent are invalid. One or more claims of the '626 Patent are invalid for failure to satisfy one or more of the requirements for patentability set forth in Title 35 of the United States Code, including without limitation, 35 U.S.C. §§ 101, 102, 103, and/or 112.

75. Absent a declaration that the claims of the '626 Patent are invalid, American Patents will continue to wrongfully assert the '626 Patent against BlackBerry in violation of the laws and contrary to the public policy of the United States of America, and will thereby continue to cause BlackBerry irreparable injury and damage.

76. Because the above activities and actions have created an actual and justiciable controversy, BlackBerry seeks a declaration that the '626 Patent is invalid.

JURY DEMAND

In accordance with Fed. R. Civ. P. 38(b), BlackBerry demands a trial by jury on all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, BlackBerry prays that the Court enter judgment in its favor and against American Patents and grant the following relief:

A. Dismiss the Complaint with prejudice and denying each and every prayer for relief contained therein;

B. Declare that none of the claims of the Patents-in-Suit are directly, indirectly or jointly infringed by the making use, sale, offer for sale or importation by BlackBerry of any of accused services or products, or any other activity attributable to BlackBerry, either literally or under the doctrine of equivalents;

- C. Declare that the claims of the Patents-in-Suit are invalid and/or patent ineligible;
- D. Declare that this case is “exceptional” within the meaning of 35 U.S.C. § 285, and that all costs and expenses of this action, including reasonable attorneys’ fees, be awarded to BlackBerry;
- E. Declare that American Patents is not entitled to any injunctive relief against BlackBerry; and
- F. Grant BlackBerry such further relief as this Court may deem necessary, just or proper.

Dated: February 5, 2019

Respectfully submitted,

/s/ Jason W. Cook

Jason W. Cook (TX 24028537)
Shaun W. Hassett (TX 24074372)
Kuan-Chieh Tu (TX24090443)
McGUIREWOODS LLP
2000 McKinney Avenue
Suite 1400
Dallas, TX 75201
(T) (214) 932-6400
(F) (214) 932-6499
jcook@mcguirewoods.com
shassett@mcguirewoods.com
gtu@mcguirewoods.com

George B. Davis (VA 83165)
McGUIREWOODS LLP
Gateway Plaza
800 East Canal Street
Richmond, VA 23219-1129
Tel: (804) 775-1000
Fax: (804) 225-5377
gdavis@mcguirewoods.com

Counsel for BlackBerry Limited

CERTIFICATE OF SERVICE

I hereby certify that on February 5, 2019, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

/s/ Jason W. Cook